

REMARKS

Claim 25 has been amended to recite the language "eluting the nucleic acid from the solid phase." Support for this amendment can be found in the specification, e.g., at page 24, lines 9-12; page 78, line 24, to page 79, line 8; page 79, line 10, to page 80, line 7; and page 80, line 9, to page 81, line 6. The amendment adds no new matter. Applicants have added no new claims. Claims 1-64 are under consideration.

Applicants thank the Examiner for the courtesies extended to Applicants' representatives during the telephone interview conducted April 10, 2003 ("Interview"). The following remarks reflect and expand upon the interview.

The amendment to claim 25 was originally filed in the Amendment After Final ("Amendment") mailed March 12, 2003. According to the Advisory Action, the amendment was not entered. During the Interview, the Examiner kindly agreed to enter the amendment to claim 25.

Rejection Under 35 U.S.C. § 112, Second Paragraph.

The Examiner rejects claims 1-24 and 41-63 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Office Action at page 2, section 2. Specifically, the Examiner stated that claims 1, 3, 4, and 41 are vague and indefinite for recitation of the term "substantially." *Id.*

During the interview conducted April 10, 2003, the Examiner stated that the §112, second paragraph, rejections should be withdrawn in view of the arguments in the Amendment filed March 12, 2003, even though they were not addressed in the Advisory Action. Applicants thank the Examiner for agreeing to withdraw the rejection under 35 U.S.C. §112, second paragraph. Applicants repeat now those arguments.

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The term "substantially" in claims 1, 3, 4, and 41 is used in the phrase "substantially neutralizing the cationic surfactant" or in the phrase "substantially neutralizes the cationic surfactant." Applicants respectfully assert that the phrase "substantially neutralizing" a cationic surfactant is specifically defined, for example, in the specification at pages 20-21, paragraphs 62 and 63. The specification states that "the term 'substantially neutralizing' the cationic surfactant, for the purposes of this application, means that more nucleic acid in a sample is capable of binding a solid phase application with such substantial neutralization than without the neutralization." Specification, page 20, lines 12-16.

The Examiner states that this argument is not convincing because "it is unclear of what exactly is 'more nucleic acid' ...," and that "there is no comparison to something else that define[s] the term more." *Id.*

The sentence at page 20, lines 12-16, of the specification, however, clearly includes a comparison. The sentence states that "'substantially neutralizing' the cationic surfactant, for the purposes of this application, means that **more** nucleic acid in a sample is capable of binding a solid phase application with such substantial neutralization **than without the neutralization.**" (Emphasis added).

The comparison is between (1) the amount of nucleic acid capable of binding a solid phase with substantial neutralization of a cationic detergent and (2) the amount of nucleic acid capable of binding a solid phase without substantial neutralization of a cationic detergent. The meaning of the sentence at page 20, lines 12-16, is quite clear to one skilled in the art.

Thus, the term "substantially" is defined with respect to claims 1, 3, 4, and 41.

Rejection Under 35 U.S.C. § 102(e)

The Examiner rejected claims 1-6, 9, 10, 14-17, 22-27, 30-33, and 38-40 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,242,188 to Dattagupta et al., ("Dattagupta"). Office Action at pages 3, section 4. In the Advisory Action, the Examiner withdrew the rejection under 35 U.S.C. §102. In the Advisory Action, however, the Examiner made it clear that she did not consider the prior arguments concerning the claim element "binding the nucleic acid to a solid phase" alone in claims 1 and 25 to distinguish the claimed invention over Dattagupta. Accordingly, Applicants withdraw those arguments that had previously been advanced in response to both the § 102 and § 103 rejections and do not assert them here.

As set forth in the Amendment filed March 12, 2003, and as agreed by the Examiner, the Examiner has not established that Dattagupta teaches obtaining nucleic acids from a biological sample comprising substantially neutralizing a cationic surfactant as set forth in independent claim 1. Also, as set forth in the Amendment filed March 12, 2003, and as agreed by the Examiner, the Examiner has not established that Dattagupta teaches obtaining nucleic acids from a biological sample comprising eluting the nucleic acid from the solid phase as set forth in independent claim 25.

Applicants thank the Examiner for the withdrawal of the rejection under 35 U.S.C. §102.

Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-40 under 35 U.S.C. § 103(a) as allegedly being obvious over Dattagupta in view of U.S. Pat. No. 5,130,423 to Van Ness et al. ("Van Ness"). Office Action, pages 3 to 4, section 6.

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Claim 1 recites in part a method for obtaining nucleic acids from a biological sample comprising "substantially neutralizing the cationic surfactant." Dependent claims 2-24 ultimately depend from claim 1, and thus include all of the elements of claim 1. As discussed in the Amendment filed March 12, 2003, Dattagupta does not disclose a method for obtaining nucleic acids from a biological sample comprising substantially neutralizing the cationic surfactant.

In the Advisory Action, the Examiner stated that Van Ness taught "the 'substantially neutralizing the cationic surfactant' step in col 2-3, where it is stated that 'the use of bentonite in combination with the extraction solutions allows the rapid and simple recovery of intact RNA, DNA ...'"

As noted during the Interview, Van Ness discusses the use of bentonite as an RNase inhibitor, but not as an agent for neutralizing a cationic surfactant. Van Ness does not teach and would not have suggested a method for obtaining nucleic acids comprising substantially neutralizing the cationic surfactant.

During the interview, the Examiner agreed with Applicants that this argument with regard to claim 1 was persuasive.

Claim 25 as amended recites a method for obtaining nucleic acids from a biological sample comprising "eluting the nucleic acid from the solid phase." During the Interview, the Examiner kindly agreed to enter the amendment to claim 25. Dependent claims 26-40 ultimately depend from claim 25, and thus include all of the elements of claim 25.

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Dattagupta does not disclose a method for obtaining nucleic acids from a biological sample comprising eluting the nucleic acid from the solid phase. Dattagupta would not have suggested such a method.

As noted during the interview, Van Ness does not teach and would not have suggested a method for obtaining nucleic acids comprising eluting the nucleic acid from the solid phase. During the Interview, the Examiner agreed with the Applicants that the argument with regard to claim 25 was persuasive.

Thus, the combination of Dattagupta and Van Ness would not have rendered obvious any of claims 1-40.

Applicants respectfully request withdrawal of the § 103 rejections of claims 1-40 in view of Dattagupta and Van Ness.

Conclusion

Applicants respectfully assert that the application is in condition for allowance. If the Examiner does not consider the application to be in condition for allowance, or has any questions regarding the application or the interview, Applicants request that the Examiner call the undersigned ((650) 849-6676) prior to taking action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: April 14, 2003

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